

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 1-52 are pending. Claims 1-52 stand rejected.

Claims 1, 19, 20, 31, 38, 39, 43, 45-48, and 50 have been amended. No claims have been canceled. No claims have been added. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. Applicants submit that the amendments do not add new matter.

Applicants reserve all rights with respect to the applicability of the Doctrine of Equivalents.

Examiner objected to the disclosure "because it contains an embedded hyperlink and/or other form of browser-executable code" (Office Action, page 3, 04/16/07).

Applicants have amended paragraph [0006] of the specification to remove the embedded hyperlink and/or other form of browser-executable code.

With respect to other portions of the specification, applicants respectfully draw the Examiner's attention to MPEP §608.01, paragraph 6.32.01, section VII, which states:

Where the hyperlinks and/or other forms of browser-executable codes themselves rather than the contents of the site to which the hyperlinks are directed are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. §112, first paragraph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks.  
(MPEP §608.01, paragraph 6.32.01, section VII)

Applicants respectfully submit that the hyperlinks objected to are present in the Detailed Description section of the specification (paragraph [0078]) as examples of addresses. Thus, the hyperlinks objected to are included to comply with §112 and are not intended to be active.

Accordingly, applicants respectfully request withdrawal of the objection to the specification under MPEP §608.01.

## **CLAIMS OBJECTIONS**

The Examiner stated that claim 20 and claims 21-23 depending thereon are directed to an article, but claim 20 depends on claim 18, which is a method.

Applicants have amended claim 20 to depend from claim 19.

Therefore, applicants respectfully submit that the Examiner's objection to claim 20 has been overcome.

Given that claims 21-23 depend from amended claim 20, applicants respectfully submit that the Examiner's objections to claims 21-23 have been overcome.

## **REJECTIONS UNDER 35 U.S.C. § 101**

The Examiner has rejected claims 19-42 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Examiner asserts that "an electronic transmission signal does not fall within any of the four categories of invention." (Office Action, p. 3, 7/17/07)

Applicants have amended paragraph [0038] of the Specification to remove "electrical, optical, acoustical or other form of propagated signals (e.g., carrier waves, infrared signals, digital signals, etc.);".

Therefore, applicants respectfully submit that the Examiner's rejection of claims 19-42 under 35 U.S.C. §101 has been overcome.

## **REJECTIONS UNDER 35 U.S.C. § 112**

The Examiner has rejected claim 50 under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner states that claim 50 recites the limitation "the sheet" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Applicants have amended claim 50 to overcome the Examiner's rejection under 35 U.S.C. §112, second paragraph.

## REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 9, 10, 15, 19, 24, 25, 29, 30, 31, 33, 34, 37, 38, 41, 44, 49, 50, and 52 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,867,821 of Ballantyne et al. ("Ballantyne").

Amended claim 1 reads as follows:

A method comprising:

representing a first collection of media objects on a first sheet having a first graphical content representing the media objects, wherein the first sheet is a cover sheet that provides access to the first collection of the media objects;

creating a second collection of media objects from the first collection of media objects; and

re-marking the first sheet to include a second graphical content representing the second collection of media objects, wherein the re-marked first sheet provides access to the second collection of the media objects.

(Amended claim 1)(emphasis added)

Ballantyne discloses method and apparatus for electronically accessing and distributing personal health care information. More specifically, Ballantyne discloses patient care stations (PCS) interconnected to a master library through a network (Figure 1). In particular, Ballantyne discloses:

... the patient record information is retrieved from the appropriate nursing station and the associated patient charts and data entry forms are displayed (386). The correct information is then entered i.e. temperature, blood pressure, medication administered, etc. and then the patient's medical record is updated (388). If the user has been identified as a physician (390) then the entire medical record (392) is made available for viewing at the bedside through the PCS. The physician then enters their personal notes, observations, etc. (394) and the patient's medical record is modified accordingly. It should be noted that no mention has been made as to the specifics of the data entry device: this can either be accomplished directly through a touch panel on the display or through a personal data assistant as will be discussed subsequently.

(Ballantyne, col. 10, lines 10-27) (emphasis added)

Thus, Ballantyne merely discloses displaying the medical record, and updating the medical record using the touch panel on the display. In contrast, amended claim 1 refers to representing a first collection of media objects on a first sheet having a first graphical content representing the media objects, wherein the first sheet is a cover sheet that provides access to the first collection of the media objects; creating a second collection of media objects from the first collection of media objects; and re-marking the first [cover] sheet to include a second graphical content representing the second collection of media objects, wherein the re-marked first sheet provides access to the second collection of the media objects.

Because Ballantyne fails to disclose all limitations of amended claim 1, applicants respectfully submit that amended claim 1 is not anticipated by Ballantyne under 35 U.S.C. §102 (b).

Given that claims 9, 10, 15, 19, 24, 25, 29, 30, 31, 33, 34, 37, 38, 41, 44, and 49 contain limitations that are similar to those discussed with respect to amended claim 1, applicants respectfully submit that claims 9, 10, 15, 19, 24, 25, 29, 30, 31, 33, 34, 37, 38, 41, 44, and 49 are not anticipated by Ballantyne under 35 U.S.C. §102 (b).

Amended claim 50 reads as follows:

A method comprising:  
erasing a portion of a sheet having a representation of a collection of media objects, wherein the representation includes graphical context to represent the media objects, wherein the sheet is a cover sheet that provides access to the collection of the media objects;  
marking the portion of the sheet with updated information.

(Amended claim 50)(emphasis added)

As set forth above, Ballantyne merely discloses updating the medical record using the touch panel on the display (col. 10, lines 10-27). In contrast, amended claim 50 refers to erasing a portion of a sheet having a representation of a collection of media objects, wherein the representation includes graphical context to represent the media objects, wherein the sheet is a

cover sheet that provides access to the collection of the media objects; and marking the portion of the sheet with updated information.

Because Ballantyne fails to disclose all limitations of amended claim 50, applicants respectfully submit that amended claim 50 is not anticipated by Ballantyne under 35 U.S.C. §102 (b).

Given that claim 52 depends from amended claim 50, applicants respectfully submit that claim 52 is not anticipated by Ballantyne under 35 U.S.C. §102 (b).

Claim 46 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2002/0052888 of Sellen et al. ("Sellen").

Amended claim 46 reads as follows:

A method comprising:  
scanning a portion of a document to obtain first scanned data;  
storing the first scanned data in a memory;  
performing an erasing operation on the scanned portion of the document at the location of the portion;  
scanning the erased portion of the document to obtain second scanned data;  
determining whether the first and second scanned data are the same to indicate whether the document was erased.

(Amended claim 46)(emphasis added)

Sellen discloses an electronic record storage. More specifically, Sellen discloses synchronizing the stored records and the printed records (Figure 5). In particular, Sellen discloses:

... the user is prompted for the action which is required, for example to "Update" the stored file with any annotations which have been made to the printed document, ... the user is prompted to scan the content 34p on the paper. Once the user has done this in step 88, then, in step 90, the scanner 26 receives and pieces together an image of the content 34p on the paper. Then, in step 92, the scanner 26 performs an optical character recognition process on the image in order to obtain the content 34p on the paper. Then, in step 94, the content is saved in the file storage with the filename that was extracted in step 60, and in step 96 the stored time 38p for the file is updated with the current time. Then, the procedure ends. Optionally, between steps 92 and 94, the user may then be allowed to edit the content and/or clarify any OCR uncertainties.

(Sellen, paragraph [0032])(emphasis added)

.... to replace the current stored version of the document with the paper version, including any annotations that have been made.  
(Sellen, paragraph [0037])(emphasis added)

Thus, Sellen merely discloses replacing the stored version of the document with the data received from the scanned paper version. In contrast, amended claim 46 refers to performing an erasing operation on the scanned portion of the document at the location of the portion; and scanning the erased portion of the document to obtain second scanned data.

Because Sellen fails to disclose all limitations of amended claim 46, applicants respectfully submit that amended claim 46 is not anticipated by Sellen under 35 U.S.C. §102 (b).

Claim 47 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2002/0064113 of Geeslin. (“Geeslin”).

Amended claim 47 reads as follows:

A method comprising:  
detecting a writable mark when scanning a coversheet, wherein the coversheet includes a re-writable paper;  
preventing modification to the coversheet in response to detecting the writable mark.

(Amended claim 47)(emphasis added)

Geeslin, in contrast, discloses methods for protecting optical disk media (Abstract). In contrast, amended claim 47 refers to detecting a writable mark when scanning a coversheet, wherein the coversheet includes a re-writable paper; and preventing modification to the coversheet that includes a re-writable paper in response to detecting the writable mark.

Because Geeslin fails to disclose all limitations of amended claim 47, applicants respectfully submit that amended claim 47 is not anticipated by Geeslin under 35 U.S.C. §102 (b).

#### **REJECTIONS UNDER 35 U.S.C. § 103**

Claims 2-8, 12, 13, 20-23, 32, 27, 28, 36, 39, 40, 42, 43, 45, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ballantyne, in view of U.S. Patent No. 6,396,598 of Kashiwagi et al. (“Kashiwagi”).

It is respectfully submitted that Ballantyne does not teach or suggest a combination with Kashiwagi, and Kashiwagi does not teach or suggest a combination with Ballantyne. It would be impermissible hindsight, based on applicants' own disclosure, to combine Ballantyne and Kashiwagi.

As set forth above, Ballantyne teaches electronically accessing and distributing personal health care information.

Kashiwagi, in contrast, teaches adding an electronic memo to a document (Abstract).

Furthermore, even if accessing and distributing the personal health care information of Ballantyne were combined with adding the electronic memo to the document of Kashiwagi, such a combination would still lack representing a first collection of media objects on a first sheet having a first graphical content representing the media objects, wherein the first sheet is a cover sheet that provides access to the first collection of the media objects; creating a second collection of media objects from the first collection of media objects; and re-marking the first [cover] sheet to include a second graphical content representing the second collection of media objects, wherein the re-marked first sheet provides access to the second collection of the media objects, as recited in amended claim 1.

Given that claims 2-8, 12, 13, 20-23, 32, 27, 28, 36, 39, 40, 42, 43, 45, and 48 contain the limitations that are substantially similar to those discussed with respect to amended claim 1, applicants respectfully submit that claims 2-8, 12, 13, 20-23, 32, 27, 28, 36, 39, 40, 42, 43, 45, and 48 are not obvious under 35 U.S.C. § 103(a) over Ballantyne in view of Kashiwagi.

Claims 11, 26, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ballantyne, in view of U.S. Patent No. 3,713,148 of Cardullo et al. ("Cardullo").

It is respectfully submitted that Ballantyne does not teach or suggest a combination with Cardullo, and Cardullo does not teach or suggest a combination with Ballantyne. It would be

impermissible hindsight, based on applicants' own disclosure, to combine Ballantyne and Cardullo.

As set forth above, Ballantyne teaches electronically accessing and distributing personal health care information. Cardullo, in contrast, teaches the transponder apparatus and system (Abstract).

Furthermore, even if accessing and distributing the personal health care information of Ballantyne were combined with the transponder apparatus and system of Cardullo, such a combination would still lack representing a first collection of media objects on a first sheet having a first graphical content representing the media objects, wherein the first sheet is a cover sheet that provides access to the first collection of the media objects; creating a second collection of media objects from the first collection of media objects; and re-marking the first [cover] sheet to include a second graphical content representing the second collection of media objects, wherein the re-marked first sheet provides access to the second collection of the media objects, as recited in amended claim 1.

Given that claims 11, 26, and 35 contain the limitations that are substantially similar to those discussed with respect to amended claim 1, applicants respectfully submit that claims 11, 26, and 35 are not obvious under 35 U.S.C. § 103(a) over Ballantyne in view of Cardullo.

Claims 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ballantyne, in view of U.S. Patent No. 6,260,063 of Ludtke et al. ("Ludtke")

It is respectfully submitted that Ballantyne does not teach or suggest a combination with Ludtke, and Ludtke does not teach or suggest a combination with Ballantyne. It would be impermissible hindsight, based on applicants' own disclosure, to combine Ballantyne and Ludtke.

As set forth above, Ballantyne teaches electronically accessing and distributing personal health care information. Ludtke, in contrast, teaches the representing devices and available information within a network of devices (Abstract).

Furthermore, even if accessing and distributing the personal health care information of Ballantyne were combined with the network of devices of Ludtke, such a combination would still lack representing a first collection of media objects on a first sheet having a first graphical content representing the media objects, wherein the first sheet is a cover sheet that provides access to the first collection of the media objects; creating a second collection of media objects from the first collection of media objects; and re-marking the first [cover] sheet to include a second graphical content representing the second collection of media objects, wherein the re-marked first sheet provides access to the second collection of the media objects, as recited in amended claim 1.

Given that claims 16-18 contain the limitations that are substantially similar to those discussed with respect to amended claim 1, applicants respectfully submit that claims 16-18 are not obvious under 35 U.S.C. § 103(a) over Ballantyne in view of Ludtke.

Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ballantyne, in view of Sellen.

It is respectfully submitted that Ballantyne does not teach or suggest a combination with Sellen, and Sellen does not teach or suggest a combination with Ballantyne. It would be impermissible hindsight, based on applicants' own disclosure, to combine Ballantyne and Sellen.

As set forth above, Ballantyne teaches electronically accessing and distributing personal health care information. Sellen, in contrast, teaches the electronic record storage (Abstract).

Furthermore, even if accessing and distributing the personal health care information of Ballantyne were combined with the electronic record storage of Sellen, such a combination would still lack erasing a portion of a sheet having a representation of a collection of media objects, wherein the representation includes graphical context to represent the media objects, wherein the sheet is a cover sheet that provides access to the collection of the media objects; and marking the portion of the sheet with updated information, as recited in amended claim 50.

Given that claim 51 contains the limitations that are substantially similar to those discussed with respect to amended claim 50, applicants respectfully submit that claim 51 is not obvious under 35 U.S.C. § 103(a) over Ballantyne in view of Sellen.

It is respectfully submitted that in view of the amendments and arguments set forth herein, the applicable rejections and objections have been overcome. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300. If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 10/17/07 By: Karen  
Tatiana Rossin, Reg. No. 56,833

1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040  
(408) 720-8300

Customer No. 008791